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APR 02 2007

Appl. No. 10/687,748

Reply to Office action of 01/04/2007

REMARKS/ARGUMENTS

The title of the invention has been amended to delete "and process" in view of the restriction.

In the specification, publication paragraph 0033 has been amended as suggested by the examiner.

Claims 1 - 16 were rejected. Claim 1 has been amended. Amended claim 1 and claims 2 - 16 are presented for reconsideration.

Claims 17 - 19 are withdrawn and your applicant reserves the right to file a divisional application.

35 USC 102(b) Rejection

Claims 1 - 3, 5 and 11 - 15 are rejected under 35 USC 102(b) as being anticipated by Cox (U.S. 4,754,746). This rejection is traversed as not being in compliance with the requirement for an anticipation rejection. In any event, to preclude any misunderstanding, the structure of claim 1 has been further clarified.

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35 USC 103(a) Rejections

Claims 4, 6 - 8 and 16 are rejected under 35 USC 103(a) as being unpatentable over Cox in view of Hastings (U.S. 4,269,089). The rejection is traversed.

Claim 9 is rejected under 35 USC 103(a) as being unpatentable over Cox in view of Steinweg (U.S. 6,347,565). The rejection is traversed.

Claim 10 is rejected as claim 9 further in view of Tiedemann (U.S. 2003/0233119). The rejection is traversed.

Anticipation Rejections

Claim 1 is drawn to a phimosis curer with blades that are insertable into a foreskin opening (lines 13 and 24). Lines 17 and 18 require that "a ratchet means pivots between" the handle grips (emphasis added). The ratchet means of Cox has an arcuate segment 6 that has one end permanently fixed to one handle 1 and a second end that extends through a slot 8 in the second handle 1. The arcuate segment travels through the slot in a fixed arcuate path. There is no pivotal movement of a ratchet means between a first and second handle grip in Cox. Lines 21 - 24 recite "a first enlarged hook means" and "a second enlarged hook means" to prevent a

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foreskin from slipping out of the blades. Cox has no enlarged hook means. The structure of Cox is designed to be a self-retaining metatarsal spreader.

As set forth in column 2, lines 49 - 57, the jaws of Cox are formed so as to provide an opening through which a neuroma can be excised from bones separated by the jaws 4 of the spreader. As stated in the paragraph sharing columns 2 and 3, the blades 5 are rectangular and of uniform width from the top to the bottom. The blades are flared, curved, and depressed to form a concave bone receptive area having "criss-crossed ribs to bite into tissue surrounding the bones and thereby prevent slippage." (Column 3, lines 22 - 38). The reference number 21 is not an enlarged hook, it is a recess or cavity bent into the front end of the blade. The reference to Cox does not provide the same structure nor perform the same function required by claim 1.

It is clear that Cox's spreader is designed to firmly grasp and hold the circular area of the jaws in a specific location adjacent the cylindrical hard bones of the foot while the present invention is to indiscriminately stretch the relatively elastic foreskin without doing damage.

Claim 1 is not anticipated by Cox.

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Claim 2 depends from claim 1 and is not anticipated as it includes the limitations recited in claim 1 that are not taught by Cox.

Claim 3 requires a curved rack first end to be attached to a first handle grip second end by a first pivot pin. Neither end of the curved rack of Cox is attached by a pin and so claim 3 per se is not anticipated.

Claim 5 requires the curved rack irregular cog surface to pivot toward and away from the pawl for engagement. Since the rack of Cox is fixed, there is no pivotal movement of the rack and thus no anticipation of claim 5 per se.

Claim 11 depends from claim 1 and is not anticipated as it includes the limitations recited in claim 1 that are not taught by Cox.

Claim 12 requires a bias means with the first pivot pin. Since Cox has no pivot pin with the ratchet there can be no bias means with it and there is thus no anticipation of claim 12 per se..

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Claim 13 requires the phimosis curer to be all one integral shaped spring element. Cox neither teaches one integral part nor manufacture by shaping a spring element and thus does not anticipate claim 13 per se.

Claim 14 requires first and second jaws to criss-cross with the grips united. Cox does not teach this structure and does not anticipate claim 14 per se.

Claim 15 requires that the ratchet means be engaged by placement of the handle grip within a cog of the rack. Cox does not teach this and thus does not anticipate claim 15 per se.

Obviousness Rejections

Claims 4, 6 - 8 and 16 are rejected as being obvious over Cox in view of Hastings.

Claims 4 and 6 - 8 depend from claims 1, 2 and 3. The deficiencies of claims 1, 2 and 3 are set forth under the 35 USC 102 rejection above. Hastings teaches pliers where the jaws approach each other as the handles approach each other. There is no provision in Hastings for stretching a foreskin or biasing a foreskin into a stretched condition. There are no upwardly extending blades in Hastings. Hastings does not teach the jaws and handles joined together. There is no ratchet means pivoted on a handle. The ratchet is a part of one handle. The ratchet

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does not prevent the handles from moving away from each other. There are no enlarged hook means on Hastings. Claims 4 and 6 - 8 require a curved rack but Hastings has no curved rack and so the details of the rack claimed cannot be taught by Hastings.

The patent to Hastings is drawn to a non-analogous art, teaches away from the teaching of Cox and provides no teachings for combining and, if combined, would render Cox inoperative for the intended purpose. Combining Cox and Hastings is not obvious and, if combined, would not result in the claimed structure or claimed function.

Claim 9 is rejected as being obvious over Cox in view of Steinweg.

Steinweg teaches multi-use pliers that function in the same manner as those of Hastings and has all the deficiencies of Hastings recited above. The entire structure of Steinweg is for standard pliers type movements. The structure taught by Steinweg does not cure the deficiencies of Cox. Steinweg is cited by the examiner as teaching a ball shape hook. The ball shape of Steinweg cited by the examiner is shown in Figs. 8 and 9. Steinweg uses the structure of Figs. 8 and 9 in his pliers as "a hose pull off" or "for piston ring tips" (column 4, lines 60 and 61). The pliers of Steinweg are drawn to non-analogous art. The structure is not compatible with that of Cox. There is no teaching to make the combination. There is no teaching in either reference of

the claimed function. The examiner has made a hindsight reconstruction of the prior art to reject the claims. Further there is no structure or teaching in either Cox or Steinweg of "finished smooth curved surfaces with spaces provided to preclude damage to the penis glands and from pinching the foreskin" as required by claim 9. Combining Cox and Steinweg is not obvious and, if combined, would not result in the claimed structure.

Claim 10 is rejected as claim 9 and further in view of Tiedemann. Tiedemann teaches a pair of forceps having non-slip coatings. The teaching of Tiedemann that a non-slip coating can be applied to forceps, or anything else, does not overcome the deficiencies of Cox and Steinweg. Neither does it make obvious applying a coating to an enlarged hook or that of using a hook with the structure recited in claim 9. Further applying a rubber or plastic coating to the blades of Cox or Steinweg would render them inoperative for their intended purposes of gripping (Cox 21 and Steinweg column 4, lines 60 and 61).

Applicable Law

As to anticipation, no legally acceptable anticipation rejection has been made. The basic requirements necessary for making a 35 USC 102(b) rejection have not been complied with. To constitute an appropriate rejection under 35 USC 102(b) requires that the disclosure or prior patents be read unaided by teachings of the subject matter which they are alleged to anticipate.

Technical Tape Corp. V. Minnesota Mining and Mfg. Co., 110 USPQ 160 (D.C.S.D. NY 1957).

There can be no 35 USC 102 anticipation unless all of the same elements are found in exactly the

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same situation and united in the same way to perform identical functions as a single prior art reference. Corometrics Medical Systems v. Berkeley Bio-Engineering, 193 USPQ 467 (D.C.N.D. Calif. 1977); Johnson & Johnson v. Gore & W.L. Gore & Assoc., 195 USPQ 487 (D.C. Del. 1978); Scott v. Inflatable System, 222 USPQ 460 (9th Cir. 1983).

No legally acceptable obviousness rejection has been made.

The art applied does not meet the claim preamble. As here, when a preamble is essential to understanding the claim itself, the relevant prior art is limited. Freund Industrial Co. V. Driam Metall Product GmbH Co., 12 USPQ 2d 1641 (DCSNY 1989). While the preamble is not normally considered part of the claim, it is deemed part of the claims where necessary to breath “life and meaning” into the claims. Corning Glass Works v. Sumitomo Electric USA, 9 USPQ 2d 1962 (Fed Cir 1989). The purpose set forth in the preamble is more than a mere statement of purpose, it is essential to particularly point out the invention defined by the claims. The limitations appearing in the preamble are necessary to give meaning to the claims and properly define the invention. In re Bullock, 203 USPQ 17 (CCPA 1979); Computervision Corp., 221 USPQ 669 (Fed Cir) cert. Denied, 469 U.S. 857 (1984).

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As stated by the Federal Circuit: a court charged with claim construction must construe the preamble and the remainder of the claim as one unified and internally consistent recitation of the claimed invention, when the preamble is not merely a statement describing the invention's intended field of use but instead is intimately meshed with the ensuing language in the claim. The first appearance of terms in the claim body in this case could only be understood or discerned in the context of the preamble's use of those terms. Pitney Bowes v. Hewlett Packard, 51 USPQ 2d 1161 (CAFC 1999).

There is no teaching in the references to make the combination modification suggested. The mere fact that the prior art can be modified does not make the modification obvious or establish *prima facie* obviousness unless the prior art suggests the desirability of the modification. In re Gordon, 221 USPQ 1125 (CAFC 1984). The Court of Appeals for the Federal Circuit stated that combining separate teachings in prior art references to establish a case for obviousness must be based on a suggestion or motivation therefor in the prior art. W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed.Cir. 1983). References may not be combined indiscriminately and it must be determined whether the prior art suggests doing what Applicant is doing. In re Shaffer, 108 USPQ 326 (CCPA 1956). A combination of references which requires a change in the basic principle under which the basic reference was designed to operate is improper. In re Ratti, 123 USPQ 349 (CCPA 1959). The claimed

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invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, 221 USPQ 481 (FedCir 1984). The Federal Circuit has emphatically stated that a suggestion, teaching, or motivation to combine prior art references is an essential component of an obviousness holding. This need for specificity pervades precedential authority and that teachings of references can be combined only if there is some suggestion or incentive to do so. In re Sang-Su Lee, No. 00 - 1158 (Fed.Cir. Jan. 18, 2002).

The examiner has ignored claim limitations. The claim requirements cannot simply be ignored. The applied references do not teach or support the materials, elements nor the coupling of the elements. Ehreich et al 200 USPQ 504 (CCPA 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 2 USPQ 2d 1276 (CAFC 1987); In re Fine 5 USPQ 2d 1596 (CAFC 1988).

The examiner has indiscriminately combined references. An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled

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in the art to do what the patent applicant has done. Ex parte Levengood, 28 USPQ 2d 1300 (BdApp 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under §103, “the teachings of references can be combined only if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (CAFC 1984). The requirements of a claim cannot simply be ignored. In re Ehhreich et al, 200 USPQ 504 (CCPA 1979) and must be considered material absent external evidence suggesting otherwise. Ontario Die of America v. Independent Die, 18 USPQ 2d 1477 (DCE Mich 1990); In re Boe, 184 USPQ 38 (CCPA 1974); Ex parte Murphy & Burford, 217 USPQ 479 (BdApp 1982).

The claims and references address different problems. The prior art must address and provide the inventor's answer to the particular problem confronting an inventor. In re Winslow, 151 USPQ 48 (CCPA 1966). The relationship between the problem the inventor was attempting to solve and the problem to which any prior art reference is directed is highly relevant. Stanley Works v. McKinney Mfg. Co. 216 USPQ 298 (Del DC 1981); In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965). To show obviousness, the structure of the references must function in essentially the same way to produce substantially the same result. Pennwalt Corp. V. Durance Wayland, Inc., 4 USPQ 2d 1737 (CAFC 1987).

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The rejections are based on hindsight. More than an opinion or speculation and hindsight are required to reach a legal conclusion of obviousness. In re Sporck, 133 USPQ 360 (CCPA 1962). A combination rejection must be supported by something other than applicant's own disclosure. In re Shaffer, 108 USPQ 326 (CCPA 1956). To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record suggest that knowledge is hindsight where that which only the inventor taught is used against its teacher. W.L. Gore & Associates v. Gorlock Inc., 220 USPQ 303 (CAFC 1983); In re Harry Spinnoble, 160 USPQ 237 (CCPA 1969).

The use of appellant's disclosure in reconstruction of references to meet claims is barred since, under 35 USC 103, obviousness must be tested at the time the invention was made; and, claims are allowable when the only source which would leave a person of ordinary skill to make the last step in reconstruction is appellant's disclosure, In re Pavlecka, 138 USPQ 152 (CCPA 1963).

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CONCLUSION

The claims are definite and define patentable structure and are in condition for allowance.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted

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